

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
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Michael AU, et al.	:	Confirmation Number: 3098
	:	
Application No.: 10/751,742	:	Group Art Unit: 3625
	:	
Filed: January 5, 2004	:	Examiner: J. Dunham
	:	
Appeal No. 2009-012763	:	
	:	
For: SUPPLIER HUB WITH HOSTED SUPPLIER STORES	:	

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated September 23, 2010 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellants respectfully submit that in the Decision, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief of February 6, 2008, and in the Reply Brief of November 30, 2008. Appellants will specifically identify these particular points below.

REMARKS

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus, the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000). Substantial evidence means "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Richardson v. Perales, 402 U.S. 389, 401 (1971).

On February 26, 2010, the precedential opinion of Ex parte Frye, Appeal 2009-006013, was issued by the Board of Patent Appeals and Interferences (BPAI). Referring to the first full paragraph on page 15 of Ex parte Frye, the following was stated:

Our decision is limited to the finding before us for review. The Board does not "allow" claims of an application and cannot direct an examiner to pass an application to issuance. Rather, the Board's primary role is to review adverse decisions of examiners including the findings and conclusions made by the examiner. See 37 C.F.R. § 41.50(a)(1) ("The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner").[footnote 2 omitted] (underline added)

The Honorable Board further went on to state within Ex parte Frye that:

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. See Oetiker, 977 F.2d at 1445 ("In reviewing the examiner's

1 decision on appeal, the Board must necessarily weigh all of the evidence and
2 argument.”) (emphasis added); *see also* 37 C.F.R. § 41.37(c)(1)(vii) (appeal brief
3 must include “the contentions of appellant with respect to each ground of
4 rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis
5 therefor, with citations of the statutes, regulations, authorities, and parts of the
6 record relied on”). Specifically, the Board reviews the particular finding(s)
7 contested by an appellant anew in light of all the evidence and argument on that
8 issue. (emphasis added)
9

10 As discussed above, Appellants identify the issues to be reviewed, and the decision of the
11 BPAI is limited to the findings and conclusions made by the Examiner.¹ Additionally, a
12 complete *de novo* review is to be performed on all issues that are raised by Appellants without
13 deference to the positions taken by the Examiner.
14

15 In the first full paragraph on page 9 of the Decision, the Honorable Board presented the
16 following arguments:

17 Turning to the Appellants’ second argument, the Appellants argue that
18 Haynes does not describe that “a user is able to access a supplier catalog, which is
19 separate from the aggregated catalog.” App. Br. 15. However, claim 1 does not
20 require that the supplier catalog is separate from the aggregated catalog as the
21 Appellants seem to argue (*Id.*) Claim 1 states “providing a buyer with access to
22 said aggregated catalog and *separate access* to at least one of said plurality of
23 supplier catalogs on said commerce site.” (Emphasis added.) It is the “access” that
24 is separate and not the catalogs. “Many of appellant’s arguments fail from the
25 outset because, . . . they are not based on limitations appearing in the claims . . .”
26 *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). (emphasis in original)

¹ Although the Honorable Board can employ findings and/or analysis not of record, doing requires the designation of a new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). *See, e.g., In re Kumar*, 418 F.3d 1361, 1365. (Fed. Cir. 2005); *In re DeBlauwe*, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984).

Although not explicitly stated, the Honorable Board appears to have refused to consider Appellants' arguments on the basis that these arguments were not properly framed. Appellants' position is that this constitutes 'misapprehending' or 'overlooking' certain arguments within the meaning of 37 C.F.R. § 41.52(a)(1).

Appellants respectfully disagree that the facts at issue do not lend themselves to application of the case law discussed within In re Self. The Court within In re Self asserted the following:

Many of appellant's arguments fail from the outset because, as the solicitor has pointed out, they are not based on limitations appearing in the claims. Thus, it is immaterial that Binckley is a variable head device, while the claimed invention is contemplated to be a constant head device, because appellant's claims are not limited to the latter. It is equally immaterial, with respect to claim 22, that Binckley uses a plug to obtain his desired result, as nothing in that claim precludes the use of a plug with the claimed subject matter. It matters not that Binckley does not operate in the same way to accomplish the same result where appellant has not limited his claims according to function or result.

The Court found that the limitations at issue were not found in the claims. However, this cannot be said of the present application.

On page 15, lines 5-12 of the Appeal Brief, Appellants presented the following arguments:

On page 12 of the First Office Action, Appellants also noted that claims 1, 7, 13, and 19 were amended to clarify that a user is able to access a supplier catalog, which is separate from the aggregated catalog. This limitation is neither taught nor suggested by Haynes. On page 3 of the Second Office Action, the Examiner cited a passage in paragraph [0047], which states that "[s]uch an interface permits a buyer to search a catalogue of products and/or services of a particular supplier." However, absent from this passage and the Examiner's

1 analysis is an identification of a user being capable of accessing two separate
2 catalogs, one catalog being the aggregated catalog and the second catalog being a
3 supplier catalog. (emphasis in original)
4

5 The claim limitations from independent claim 1 is reproduced below:

6 providing a buyer with access to said aggregated catalog and separate
7 access to at least one of said plurality of supplier catalogs on said commerce site.
8

9 Although Appellants did not refer to the precise language within claim 1, Appellants are
10 unaware of any requirement that the precise language of a claim be employed when presenting
11 an argument. Appellants' position is that Appellants' arguments properly raised the issue as to
12 whether or not Haynes identically discloses all of the limitations at issue (i.e., the passage
13 immediately reproduced above from claim 1). Raising the issue on appeal is all that is required
14 by Ex parte Frye.
15

16 Notwithstanding that Appellants have properly raised the issue on appeal, Appellants'
17 arguments were based upon Appellants' interpretation of the claims. The general assumption is
18 that different terms have different meanings. Applied Medical Resources Corp. v. United States
19 Surgical Corp., 448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006), and a proper claim interpretation gives
20 full effect to the recitation of two distinct elements. Unique Concepts, Inc. v. Brown, 939 F.2d
21 1558, 1561-62 (Fed. Cir. 1991). Appellants' argued position was that two separate catalogs are
22 provided (i.e., at least of the supplier catalogs and the aggregated catalog), which is a properly
23 supported claim construction argument. Coincident with this argument is the notion that these
24 two separate catalogs are separately accessed (i.e., "access to said aggregated catalog and
25 separate access to at least one of said plurality of supplier catalogs").

1
2 The Honorable Board's position that Appellants' arguments are not based on limitations
3 appearing in the claims necessarily requires a claim construction that was not in the record prior
4 to the Decision and is still not within the record after the Decision. The Patent Office has the
5 initial burden to set forth the basis for any rejection so as to put Applicant on notice of the
6 reasons why Applicant is not entitled to a patent on the claim scope that Applicant seeks – the
7 so-called "*prima facie* case." In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992); In re Piasecki,
8 745 F.2d 1468, 1472 (Fed. Cir. 1984). "Both anticipation under § 102 and obviousness under §
9 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims.
10 Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).
11 Reference is also made to 37 C.F.R. § 1.2, which states "[t]he action of the Patent and Trademark
12 Office will be based exclusively on the written record in the Office." By disagreeing with
13 Appellants' stated claim construction, the Honorable Board has necessarily construed the
14 language of the claims differently. However, this claim construction is not within the written
15 record.

16
17 Appellants note that the Examiner, within the Examiner's Answer, did not challenge
18 Appellants' arguments as being (i) based upon an improper claim construction and/or (ii) or not
19 based upon limitations appearing in the claims. Instead, these arguments were raised (or
20 implied), for the first time, by the Honorable Board. Referring In re DeBlauwe, supra, the
21 Federal Circuit stated "[w]here the board makes a decision advancing a position or rationale new
22 to the proceedings, an applicant must be afforded an opportunity to respond to that position or
23 rationale by submission of contradicting evidence"). Here, the new positions advanced by the

1 Honorable Board is that Appellants' arguments are not based upon the language of the claims and
2 a new claim construction not within the record. Not only were these positions not taken by the
3 Examiner, had the Examiner taken these positions Appellants could have easily rephrased their
4 arguments to simply argue Haynes does not identically disclose "providing a buyer with access
5 to said aggregated catalog and separate access to at least one of said plurality of supplier catalogs
6 on said commerce site" while separately construing the claim language as Appellants in the
7 manner found on page 15, lines 5-12 of the Appeal Brief.

8
9 In brief, Appellants' positions are as follows:

- 10 (1) Appellants properly raised the issue (i.e., whether or not Haynes identically
11 discloses "providing a buyer with access to said aggregated catalog and separate access to
12 at least one of said plurality of supplier catalogs on said commerce site") on appeal,
13 which is all that is required by Ex parte Frye;
- 14 (2) Appellants' arguments are based upon the language of the claims;
- 15 (3) the argument that Appellants' arguments are not based upon the language of the
16 claims is a new grounds of rejection raised, for the first time, by the Honorable Board,
17 which constitutes a new grounds of rejection; and
- 18 (4) the Honorable Board's position that Appellants' arguments do not reflect the
19 language of the claims necessarily requires a claim construction, which is not of record
20 and also constitutes a new grounds of rejection.

21
22 Therefore, Appellants respectfully request that the Honorable Board review the issue
23 raised by Appellants (i.e., whether or not Haynes identically discloses "providing a buyer with
24 access to said aggregated catalog and separate access to at least one of said plurality of supplier
25 catalogs on said commerce site"). In the alternative, Appellants respectfully request that the
26 Honorable Board designate the Honorable Board's new analysis a new grounds of rejection so

- 1 that Appellants can avail themselves of the options found in subsections (b)(1) or (b)(2) of 37
- 2 C.F.R. § 41.50.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 23, 2010

Respectfully submitted,

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CUSTOMER NUMBER 46320